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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,939	11/21/2000	Jay C. Hsu	KCX-360 (15633)	9825

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Jason W. Johnston
Dority & Manning, P.A.
PO Box 1449
Greenville, SC 29602-1449

EXAMINER	
JOYNES, ROBERT M	

ART UNIT	PAPER NUMBER
1615	14

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/717,939	HSU ET AL.	
	Examiner	Art Unit	
	Robert M. Joynes	1615	

-- The MAILING DATE of this communication appears on the cov r sheet with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-10,12-26,28-38 and 40-52* is/are pending in the application.

4a) Of the above claim(s) *1,11,27 and 39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-10,12-26,28-38 and 40-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Receipt is acknowledged of applicants' Amendment filed on May 2, 2003 and Information Disclosure Statements filed on February 21, 2003 and May 9, 2003.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-10, 12-26, 28-38 and 40-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The instant claims recite that the lotion to be applied to a paper sheet is an oil-in-water emulsion. The claims further recite that the water is present in an amount of about 10% to about 75% by weight of the lotion. It is unclear to the Examiner upon looking at the concentrations for the oil components of the lotion how water can be present in about 10% and still constitute an oil-in-water emulsion. Water needs to be present in an amount greater than that of the oil components to create an *oil-in*-water emulsion and it is unclear how such an emulsion can be created where the oil components are present in greater amounts than the water as recited by the instant claims. Clarification of the invention or amendment to the claims to more clearly recite an oil-in-water emulsion is suggested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 3, 6, 7, 10, 14, 15, 45, 48 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik alone or in combination with Smith et al. (US 4559157).

Krzysik alone teaches a tissue product that has been treated with a lotion composition (Col. 1, lines 41-58). The lotion composition comprises water (Col. 3, lines 1-15), polyethylene glycol (Col. 3, lines 16-27), a fatty alcohol (Col. 3, lines 28-34), an emollients (Col. 4, lines 13-24), an *emulsifier* (Col. 4, lines 13-24) as well as other ingredients for skin care (Col. 3, line 35 – Col. 4, line 10). The lotion composition adds about 0.5% to about 40% weight percent to the paper product (Col. 4, lines 26-39). The paper products the lotion is applied to are facial tissue, bath tissue, paper towels, dinner napkins and the like (Col. 4, lines 46-57). The water is present in the composition is amounts from about 30% to about 90% by weight (Col. 3, lines 1-15).

Krzysik does not expressly teach the exact ranges of the ingredients of the lotion composition. Krzysik does not expressly teach an oil-in-water emulsion but is clearly suggestive of emulsions. Krzysik even exemplifies a biphasic system in Examples 11 through 13 at Col. 8. Further Krzysik teaches the inclusion of emulsifiers such as surfactants and discusses how lipophilic ingredients can be easily emulsified with the use of various surfactants. Therefore, it is clear that Krzysik contemplated emulsions as the lotion form for application to the paper product. No criticality is seen in applicants now reciting that the lotion is an oil-in-water emulsion.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to vary the amounts of ingredients in a lotion composition. It would also be obvious form the teachings of Krzysik that emulsions can be prepared as a lotion to be applied to the paper product.

While the reference does not teach the complete concentration range, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

One of ordinary skill in the art would have been motivated to do this to prepare lotion compositions with additional ingredients that achieve the same or similar expected results. Further, one of ordinary skill would be motivated to prepare emulsions to prepare a tissue product which will contain the lotion formulation that can be applied to the paper and will remain readily available for transfer to the user's skin to protect the skin from or further irritation and redness in an efficient and cost-effective manner (Col. 1,lines 33-38).

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

One can also combine the teachings of Krzysik with the teachings of Smith. Krzysik, as discussed above, teaches components of a lotion that can be applied to a

paper product to be applied to the skin. Krzysik does not expressly teach an oil-in-water emulsion but is suggestive of preparing the lotion as an emulsion

Smith teaches an absorbent sheet that is impregnated with an oil-in-water emulsion to moisturize the skin (Col. 1, lines 29-32, 40-58). The emulsion contains about 50-85% water, about 4-12% emollient oil, about 3-10% emollient wax stabilizer, about 5-20% polyhydric alcohol emollient, about 0.5-10% detergent, about 0.025-0.75% antibacterial and about 0.1-0.5% fragrance (Col. 4, lines 30-36). Smith is relied on for the teaching of *oil-in-water emulsion* lotion formulations can be used to prepare wipe compositions that contain a lotion on the wipe sheet.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to prepare a lotion formulation for application on a paper product that is in the form of an oil-in-water emulsion.

One of ordinary skill in the art would have been motivated to do this to provide an emulsion that is effective in depositing onto the skin with an even coating of emollient and fragrance with no "skipping" or separation when the impregnated sheet is pressed or rubbed against a moist skin surface (Smith, Col. 1, lines 50-58).

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 4, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik alone or in combination with Smith, in combination with Luu et al. (US 5871763). The teachings of Krzysik and Smith are discussed above. Krzysik and Smith do not expressly teach the emollient to be C_{12} - C_{15} alkyl benzoate.

Luu teaches that suitable emollients for a lotion composition are silicones, phospholipids, oils (synthetic and natural) and benzoate ester emollients (C_{12} - C_{15} alkyl benzoate) (Col. 7, line 33 – Col. 8, line 62).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to substitute one emollient in a lotion composition for another suitable emollient.

One of ordinary skill in the art would have been motivated to do this prepare lotion compositions with emollients that provide differing properties (i.e., emollients that lubricate or moisturize the skin as opposed to those that retard moisture loss or maintain the skin moisture/vapor balance (Luu, Col. 7, lines 33-40).

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik alone or in combination with Smith, in combination with Mackey et al (US 5624676). The teachings of Krzysik are discussed above. Krzysik does not expressly teach that the emulsifier is polyoxyethylene stearyl ether or a steareth.

Mackey teaches that steareth compounds are known emulsifiers (Col. 21, lines 3-9).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to substitute any emulsifier for another suitable emulsifier, namely a steareth compound.

One of ordinary skill in the art would have been motivated to do this to prepare a lotion composition with an emulsifier that is suitable for different emollients and stabilizer agents.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik alone or in combination with Smith, in combination with Wagner et al. (US 5948416). The teachings of Krzysik and Smith are discussed above. Krzysik does not expressly teach that the humectant used is glycerin. Krzysik also does not expressly teach that the humectant is present in the lotion in amount between about 10% and 40%.

Wagner teaches a lotion composition that contains a humectant in amounts from about 0.1% to about 20% (Col. 12, lines 50-59). Wagner further teaches the humectant to be glycerin (Col. 13, lines 13-25).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik alone or in combination with Smith, in combination with Blieszner et al. (US 5648083). The teachings of Krzysik and Smith are discussed above. Krzysik and Smith do not expressly teach that the skin conditioning agent to be dimethicone.

Blieszner teaches dimethicone as a skin care compound used as a barrier agent (Col 4, lines 36-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate a skin care compound such as dimethicone into a lotion composition.

One of ordinary skill in the art would have been motivated to do this prepare a lotion that provides lubrication for the skin.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 16-44, 46, 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik alone or in combination with Smith, in combination with Wagner, further in combination with Luu, further in combination with Blieszner further in combination with Warner et al. (US 5716692). The teachings of Krzysik, Smith, Wagner, Luu and Blieszner are all discussed above. Krzysik, Smith, Wagner, Luu and Blieszner do not expressly teach the type of paper that the lotion must be incorporated on or the various methods of incorporating the lotion onto the paper.

Warner teaches a lotion composition that imparts a soft, lubricious, lotion like feel when applied to paper (Col. 3, lines 39-59). Warner further discusses the different paper that can be used for the invention (Col. 4, line 27 – Col. 8, line 33). Still further, Warner teaches the different way the paper can be treated with the lotion (Col. 16, line 32 – Col. 18, line 53).

Krzysik teaches the basic paper product treated with a lotion composition. Smith teaches the lotion can be in the form of an oil-in-water emulsion. Luu teaches the emollient to be C_{12} - C_{15} alkyl benzoate. Mackey teaches the emulsifier to be a steareth

compound. Wagner teaches the humectant to be glycerin. Blieszner teaches the skin care agent to be dimethicone. Warner teaches how to treat the paper with the lotion.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to prepare an oil-in-water emulsion lotion composition comprising water, an emollient, an emulsifier, a fatty alcohol, a skin conditioning agent and additional ingredient (an antimicrobial or a preservative) that would be suitable to treat a paper product.

One of ordinary skill in the art would have been motivated to do this to prepare a product that cleans the skin effectively while providing comfort by lubricating or moisturizing the skin.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments with respect to claims 2-10, 12-26, 28-38 and 40-52 have been considered but are moot in view of the new ground(s) of rejection. Applicants mainly argue that the Krzysik reference when viewed in its entirety does not teach the exact formulation of the instant claims and therefore does not render obvious in the instant claims.

The Examiner would like to point out that Krzysik is *suggestive* of the lotion components and formulations of the instant claims. While the exact formulations of the instant claims are not exemplified, the reference in its entirety is suggestive of various lotion formulations that can contain the components recited in the instant claims. The

additional references provided show that specific components are known in the art and that lotions that are applied to paper/wipe products can be in the form of oil-in-water emulsions. Applicants have not shown that the particular ingredients at the particular concentrations provide some unexpected result or synergistic effect when applied to paper products. Absent a showing of such, the prior rejections are maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Joynes whose telephone number is (703)

308-8869. The examiner can normally be reached on Mon.-Thurs. 8:30 - 6:00, alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Robert M. Joynes
Patent Examiner
Art Unit 1615
July 13, 2003

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600